



APPENDIX B

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,575	09/24/1999	THOMAS J. BACHINSKI	293/008-CONT	1763

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02/06/2003

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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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FISH & NEAVE - PATENT DEPT.  
REFERRED TO SWY  
NOTED BY [Signature]

DOCKETED FOR 5/6/03  
-FINAL-

# Office Action Summary

Application No.

09/406,575

Applicant(s)

BACHINSKI ET AL

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-143 is/are pending in the application.
- 4a) Of the above claim(s) 25,27-43 and 95-143 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 44-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,10,13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Newly submitted claims 25, 27-43, and 95-143 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

The original claims were only drawn to the connector device of claims 1-24 which received an action on their merits. The newly presented claims to a method of mounting, a medical graft delivery system, a method of preparing a graft for anastomosis, a graft kit, a framework, a method of performing a by-pass, a method of anastomosis, and a device for sealing a hole in a blood vessel are drawn to patentably distinct inventions from that originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25, 27-43, and 95-143 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Inventorship***

In view of the papers filed August 26, 2002, it has been found that this nonprovisional application, as now claimed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(c). The inventorship of this application has been changed by adding Rudy Mazzocchi.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

***Claim Objections***

Claims 46-52, 65-75, and 78-79 are objected as having the same scope. In particular, each of claims 46-52 have a scope, which is identical to each other. Each of claims 65-68 has an identical scope to the other. Claims 69-72 all have the same scope. Claims 73-75 all have the same scope, and claims 78 and 79 have the same scope. If these claims are allowed, Applicant will be required to cancel all but one of the duplicate claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 26 and 44-94, the phrase "cylinder-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "cylinder-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). For this reason, the phrase "cylinder-like" will be interpreted to mean "cylinder."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 44-58, and 63-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Marin et al (US 5,397,555). Marin et al meets the claim language where

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the barbs (18) twist about ribs (14) to engage the tissue to the extent required by the claim language; see Figures 1 and 2 as well as column 2, line 39 to column 3, line 15.

With regard to claim 44, since the barbs (18) of Marin are spikes and are along the longitudinal axis of Marin's device, the barbs (18) inherently are capable of engaging two blood vessels depending upon how the device is used.

With regard to claims 81 and 82, since the spikes are arranged at different axial locations along the device, if the device was first expanded on one end prior to the other end being expanded, then the spikes would extend sequentially.

With regard to claim 86, the pinching action claimed is an intended use of method of use limitation. Nonetheless, this pinching action would occur in the Marin device to the extent required because the axial length would shorten as the device is radially expanded such that the tissue between the barbs would get pinched.

With regard to claim 91, the material and the plastic limit of the cells would act to control the expansion and thus the strut would act as restraining elements to the extent required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marin et al (US 5,397,555) in view of Frantzen et al (US 5,843,164). Marin meets the claim language as set forth above but lacks the super-elastic temperature-triggered shape-memory material for the device as claimed. However, Nitinol has all these claimed properties and has been known and used in the art prior to the invention as a substitute for Palmaz stainless steel materials; see Frantzen on column 2, lines 36-55 and see Marin et al on column 1, lines 18-30. Therefore, since Frantzen teaches that it was known to use Nitinol in the art for similar devices as a substitute for Palmaz stainless steel materials, it would have prima facie obvious to substitute the same in Marin et al for the same reasons that Frantzen does the same.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738